

REMARKS

Claims 1-9 are pending in the application. In the Office Action mailed February 24, 2005, claims 1-3 are rejected under 35 U.S.C. 101 as being directed to nonstatutory subject matter. Claims 1, 4, and 7 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 4,880,417 (Yabrov et al, hereinafter "Yabrov"). Claims 2-3, 5-6, and 8-9 are objected to as being dependent on a rejected claim but indicated as being allowable if rewritten in independent form. The Examiner has also reminded the Applicant of the requirement that the Abstract not exceed 150 words in length.

I. Amendments to the Abstract

The Applicant has amended the Abstract to have less than 150 words. No new matter has been added by this amendment. The Applicant thanks the Examiner for bringing the issue of the number of words in the Abstract to the Applicant's attention.

II. Rejections under 35 U.S.C. 101

Claims 1-3 stand rejected under 35 U.S.C. 101 as being directed to nonstatutory subject matter because of phrasing that inadvertently positively recited the wearer of the article. The Applicant thanks the Examiner for bringing this issue to the Applicant's attention and for suggesting alternate language. The Applicant has amended claims 1-3 to use "adapted for use with" language. No new matter has been added by this amendment. Withdrawal of the rejections under 35 U.S.C. 101 of claims 1-3, as amended, is therefore respectfully requested.

III. Rejections under 35 U.S.C. 103(a)

Claims 1,4, and 7 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 4,880,417 (Yabrov et al, hereinafter "Yabrov"). The Applicant respectfully traverses the Examiner's rejection. Yabrov does not render obvious the Applicant's invention, whether taken alone or in combination with any other art of record.

The Examiner has not cited a prior art reference to show the pear shape of the Applicant's invention, but has rather relied on the assertion that Yabrov has shown a variety of shapes and a

summary of the holding of *In Re Dailey* (357 F.2d 669, 149 USPQ 47 (CCPA 1966)). The Applicant believes that Yabrov in fact shows only one shape, a bottle-based shape that is not the equivalent of the Applicant's preferred pear shape. The Applicant concedes that a variety of shapes are known in the sanitary product art, but not, however, the beneficial pear shape of the preferred embodiment of the Applicant.

The Applicant respectfully submits that the Examiner has misapplied *In Re Dailey*. Rather than "A change of shape is generally recognized as being within the level of ordinary skill in the art", the actual holding of *Dailey* on this issue is "Appellants have presented no argument which convinces us that the particular configuration of their container is significant or is anything more than one of numerous configurations a person of ordinary skill in the art would find obvious for the purpose of providing mating surfaces ..." (149 USPQ at 50). In other words, the reason that the container shape did not render the invention of Dailey nonobvious was because it was a mere design choice rather than a part of the solution to the problem solved by Dailey's invention.

In *Dailey*, the invention was a disposable nursing container for infants. The problem solved by the invention was the swallowing of air by infants during feeding, ostensibly leading to colic. The invention solved the problem by having the container be collapsible and by the nipple having a specific form of hole so that air was not admitted as the contents were drained (*Id.* at 47). The specification stated that the shape at issue was chosen in order to provide a "container which has a rounded configuration and is convenient to hold" (*Id.* at 48). The shape at issue was acknowledged by Dailey, therefore, to have been not part of the solution provided by the invention but rather merely a design choice.

In contrast, the pear shape of the preferred embodiment of the Applicant directly provides a solution to several of the problems solved by the Applicant's invention, including the discomfort felt by many wearers of prior art devices and the tendency of prior art devices that do not amply cover the buttocks region to shift and/or leak. In the Background section of the Applicant's specification, the Applicant has presented a great deal of discussion of these long- and widely-recognized problems. In the Detailed Description section, the Applicant discusses in several places how the Applicant's pear shape solves these problems (e.g., Specification at page 7, lines 16-19; page 8, line 22 through page 9, line 4). The Applicant submits, therefore, that

there is a long-felt need for the pear shape of the Applicant's preferred embodiment, a need that has not been met despite wide recognition of the problem. Further, unlike in *Dailey*, the Applicant has clearly shown that the Applicant's choice of a pear shape is significant, being not "one of numerous configurations a person of ordinary skill in the art would find obvious" but rather part of the solution to this long-felt need. Withdrawal of the rejection of claim 1 based on Yabrov and the improper application of the holding of *In Re Dailey* is therefore respectfully requested.

The Applicant also wishes respectfully to make of record the Applicant's belief that Yabrov does not show the Applicant's porous inner layer. Element 2 of Yabrov, cited as being equivalent to the Applicant's porous inner layer, is described as being a "semi-rigid shell" that "fully lines the interior surface of outer shell 1 on one side thereof, and partially lines the interior surface of outer shell 1 on the opposite side." (Yabrov at col. 3, lines 40-55; Figs. 3-6). The semi-rigid shell of Yabrov therefore is not in contact with the body of the wearer and also specifically does not line the center of the article on the bodymost surface, in order to aid in providing the sound-muffling function of the Yabrov article. The semi-rigid shell of Yabrov also does not appear to be, or to be intended to be, porous or liquid-permeable.

In contrast, the Applicant uses the term "inner layer" in the sense that the layer is the innermost layer of the article when the article is in use on the body. The Applicant's disclosure makes it clear that the "porous inner layer" is "the top, or bodymost layer", that it is disposed along at least the central portion of the bodymost surface of the article, and that it is "liquid-permeable" (Specification at page 10, lines 11-12). The Applicant specifically states that the Applicant's invention has "no semi-rigid or rigid containment components" (Specification at page 7, lines 23-24). Replacement of the Applicant's porous inner layer with the semi-rigid shell of Yabrov in the invention of the Applicant would therefore not give the invention of the Applicant. In order to make this aspect of the Applicant's invention clear, the Applicant has herein amended claim 1 to call out that the porous, liquid-permeable layer is the bodymost layer. Support for this amendment is found at least at page 10, lines 11-12 of the specification. The Applicant's invention is therefore not obvious over Yabrov et al.

The article of claim 1 is therefore not shown in the art of record nor in any other prior art, nor is it obvious over Yabrov or any other prior art. Allowance of claim 1, as amended, is

therefore respectfully requested. Because claims 4 and 7 depend from currently amended independent claim 1, which is now in condition for allowance, claims 4 and 7 are also now in condition for allowance. Allowance of claims 4 and 7 is therefore also respectfully requested.

IV. Claim Objections/ Allowable Subject Matter

Claims 2-3, 5-6, and 8-9 stand objected to as being dependent on a rejected claim but are indicated as being allowable if rewritten in independent form. The Applicant thanks the Examiner for the indication of allowable subject matter. The Applicant has accordingly amended claim 2 to independent form and have included the elements of claim 1 from which original claim 2 depended. No new matter has been added by this amendment. The Applicant accordingly submits that claim 2, as amended, is now in condition for allowance. Because claims 3, 5-6, and 8-9 all depend from currently amended independent claim 2, which is now in condition for allowance, claims 3, 5-6, and 8-9 are also now in condition for allowance. Allowance of claims 2-3, 5-6, and 8-9 is therefore respectfully requested.

V. New Claims

The Applicant has added new dependent claims 10-14 in order to claim additional optional features of the present invention. Support for claims 10 and 11 is found at least at page 8, line 20 through page 9, line 2 of the specification and in Figs 1 and 4. Support for claims 12-14 is found at least at page 12, lines 22-23 of the specification. The Applicant has additionally added new independent claim 15 in order to claim the combination of the elements of claim 1 and claim 3 and new dependent claims 16-19 in order to claim the corresponding optional features thereof. No new matter is presented by these new claims. Entry and allowance of new claims 10-19 is therefore respectfully requested.

VI. Conclusion

Claims 1-9 have been amended. New claims 10-19 have been added. The Applicant respectfully submits that claims 1-19 are now in condition for allowance. For this reason, and in view of the foregoing arguments, the Applicant believes that this application is now in condition for allowance, which action is respectfully requested. Should there remain any unresolved

issues, it is respectfully requested that the Examiner telephone Norma E. Henderson, Applicant's Attorney, at 603-225-4334, so that such issues may be resolved as expeditiously as possible.

Respectfully Submitted,

Hinckley, Allen & Snyder LLP

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Date

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